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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/024,351
Filing Date: December 21, 2001
Appellant(s): RUBINSTENN ET AL.

Anthony M. Gutowski
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/10/2009 appealing from the Office action mailed 08/25/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

WO 01/18674	Maloney et al.	March 15, 2001
US 2002/0059030	Otworth et al.	May 16, 2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-19 and 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-10 and 24 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process should either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes should positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus which accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). Claims 1-10 and 24 identify neither the apparatus performing the recited steps nor any transformation of underlying materials, and accordingly are directed to non-statutory subject matter.

As per system claim 11, the claim recites only a computer-readable medium and *means* for enabling the recited functionalities which (means) could be understood as merely software or code per se. As such, it appears that the claim is directed to two

statutory subject classes - an apparatus and product of manufacture. So as the remaining dependent claim do not cure the identified deficiencies of independent claims, they are also rejected as being directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney et al. (WO 01/18674 A2) in view of Otworth et al. (US 2002/0059030 A1).

Maloney et al. (hereinafter Maloney) teaches a method and system and computer-readable medium for providing a customized product combination to a consumer, comprising:

Independent Claims

Claims 1 and 11.

storing personal questions on at least one topic including characteristics of at least one external body condition, the personal questions being stored on a computer-readable storage medium (page 8, lines 35 - page 9, lines 5; page 6, lines 30-34; page 18, lines 1-4, 21-24);

selecting a set of personal questions from the personal questions stored on the computer-readable storage medium (page 8, lines 35 - page 9, lines 5; page 6, lines 30-34; page 17, lines 26-29; page 18, lines 1-4, 21-24);

asking a subject the set of personal questions on at least one topic including characteristics of at least one external body condition of the subject (page 11, lines 26-30);

receiving answers to the personal questions (page 11, lines 26-27);

providing the subject with at least one set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject (page 11, lines 7-9), said "providing" step suggests a step of *selecting of* said *at least one* set of testing material;

informing the subject about the at least one set of testing material (page 11, lines 13-14).

While Maloney teaches selecting said at least one set of testing material, Maloney does not specifically teach that said set is selected *based on the received answers (subject's data)*; that said set of testing material is a *customized* set; and that said customized set is selected from a *plurality* of testing materials.

Otworth et al. teaches a method and system for analysis of remotely collected biological samples, and includes: *based upon collected historical data (subject's data)* related to a subject, providing the subject with a *customized* kit for collecting the biological sample from the subject, wherein said kit includes at least one replaceable cartridge which is determined/selected based on the tests determined to be conducted on the subject (*plurality* feature) [0043]; [0040].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said set is selected *based on the received subject's data*; that said set of testing material is a *customized* set; and that said customized set is selected from a *plurality* of testing materials, as disclosed in Otworth et al., because it would advantageously allow to accommodate said various

profile sub-categories of consumers, thereby providing each customer with said customized test kit (Maloney; page 11, lines 6-10).

Claim 20. Maloney teaches a computer-readable medium having computer-executable instructions embedded therein which, when executed by the computer, causing said computer to implement a method for providing a customized product combination to a consumer, comprising:

asking a subject the set of personal questions on at least one topic including characteristics of at least one external body condition of the subject (page 11, lines 26-30);

receiving answers to the personal questions (page 11, lines 26-27);

providing the subject with at least one set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject (page 11, lines 7-9), said "providing" step suggests a step of *selecting* of said *at least one* set of testing material;

informing the subject about the at least one set of testing material (page 11, lines 13-14).

While Maloney teaches selecting said at least one set of testing material, Maloney does not specifically teach that said set is selected *based on the received answers (subject's data)*; that said set of testing material is a *customized* set; and that said customized set is selected from a *plurality* of testing materials.

Otworth et al. teaches a method and system for analysis of remotely collected biological samples, and includes: *based upon collected historical data* related to a subject, providing the subject with a *customized* kit for collecting the biological sample from the subject, wherein said kit includes at least one replaceable cartridge which is determined/selected based on the tests determined to be conducted on the subject (*plurality* feature) [0043]; [0040].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said set is selected *based on the*

received subject's data (including answers); that said set of testing material is a *customized* set; and that said customized set is selected from a *plurality* of testing materials, as disclosed in Otworth et al., because it would advantageously allow to accommodate said various profile sub-categories of consumers, thereby providing each customer with said customized test kit (Maloney; page 11, lines 6-10).

Claim 24. Maloney teaches:

storing personal questions on at least one topic including characteristics of at least one external body condition, the personal questions being stored on a computer-readable storage medium (page 8, lines 35 - page 9, lines 5; page 6, lines 30-34; page 18, lines 1-4, 21-24);

selecting a set of personal questions from the personal questions stored on the computer-readable storage medium (page 8, lines 35 - page 9, lines 5; page 6, lines 30-34; page 18, lines 1-4, 21-24);

asking a subject personal questions on at least one topic including characteristics of at least one external body condition of the subject (page 11, lines 26-30);

receiving answers to the personal questions (page 11, lines 26-27);

providing the subject with at least one set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject (page 11, lines 7-9), said "providing" step indicates a step of *selecting* of said at least one customized set of testing material;

providing the subject with the set of testing material (page 11, lines 13-14);

ascertaining quantitative information by collecting data derived from use of the testing material on the subject (page 11, lines 15-16, 19-20);

recommending at least one beauty product to the subject based on the received answers and the ascertained quantitative information (page 12, lines 27-33).

While Maloney teaches selecting said at least one set of testing material, Maloney does not specifically teach that said set is selected *based on the received answers (subject's data)*; that said set of testing material is a *customized* set; and that said customized set is selected from a *plurality* of testing materials.

Otworth et al. teaches a method and system for analysis of remotely collected biological samples, and includes: *based upon collected historical data* related to a subject, providing the subject with a *customized* kit for collecting the biological sample from the subject, wherein said kit includes at least one replaceable cartridge which is determined/selected based on the tests determined to be conducted on the subject (*plurality* feature) [0043]; [0040].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said set is selected *based on the received subject's data (including answers)*; that said set of testing material is a *customized* set; and that said customized set is selected from a *plurality* of testing materials, as disclosed in Otworth et al., because it would advantageously allow to accommodate said various profile sub-categories of consumers, thereby providing each customer with said customized test kit (Maloney; page 11, lines 6-10).

Dependent Claims

Claims 2, 9, 10, 12, 18, 19 and 21. Same reasoning as applied to claim 1.

Claim 3. Same reasoning as applied to claim 1.

Claims 4, 13 and 22. Maloney teaches: ascertaining quantitative information by collecting data derived from use of the testing material on the subject (page 11, lines 15-16, 19-20).

Claims 5, 14 and 23. Maloney teaches: recommending at least one beauty product to the subject based on the received answers and the ascertained quantitative information (page 12, lines 27-33).

Claims 6 and 15. Maloney teaches that the customized set of testing material includes at least one of a pH indicator, sebutape, and a corneodisque indicator (page 11, lines 11-12).

Claims 7 and 16. Maloney teaches that the questions are posed to the subject over a computer network (page 8, line 35 – page 9, line 2), and wherein the at least one customized set of testing material is delivered to the subject via a courier (column 11, line 18).

Claims 8 and 17. Maloney teaches selecting and shipping an appropriate (customized) set to a customer (page 11, lines 7-9 and 18). Furthermore, Maloney teaches profiling a consumer based on consumer's physiological preferences and physiological conditions, said conditions including skin type and life stage, said profiling further includes assigning the consumer to various profile sub-categories which correspond to specific beauty product categories (page 6, line 32 – page 7, line 12), thereby suggesting that said selected (customized) set is readily available for each consumer in each of said profile sub-categories. Otworth et al. teaches that said kit includes at least one replaceable cartridge which is determined/selected based on the tests determined to be conducted on the subject [0043] (see reasoning applied to Claim 1), thereby suggesting *maintaining an inventory of a plurality of differing groups of customized sets of testing material, each group containing a combination of testing material different from a combination in another group*. The motivation to combine the references would be advantageously allowing to accommodate said various profile sub-categories of consumers, thereby providing each customer with said test kit (page 11, lines 6-10).

(10) Response to Argument

(10.01) Applicant argues that Claim Rejections under 35 USC § 101 have to be withdrawn because claims 1-10 and 24 are tied to a particular machine or apparatus because it recites a computer-readable storage medium, testing materials, and customized testing material(s).

In response to applicant argument it is noted that in order for a series of steps to be considered a proper process under § 101, a claimed process should either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes should positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus which accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). Claim 1, as currently recited, does not require a machine for performing claimed method steps. Specifically, the method steps of "selecting a set of personal questions from the personal questions stored on the computer-readable storage medium" does not require a computer for the "selecting" step. The fact that the questions are stored on the computer-readable storage medium does not mean that the "selecting" step is conducted by the computer. The questions can be printed or displayed on a screen, but the selection can be made by a person reading said questions. Same reasoning is true for the remaining steps of claim 1: "asking a subject the set of personal questions"; "receiving answers to the personal questions"; "providing the subject with at least one set of testing material for determining quantitative information that would aid in recommending at least one beauty product"; and "informing the subject about the at least one set of testing material". All these steps can be performed by a beauty consultant in a store in a person-to-person dialog between the

consultant and the subject, wherein said questions can be presented to the subject by the consultant orally, in printed form or on a computer monitor (see claim 7). Claim 24, as claim 1, also does not require a machine for performing claimed method steps. The additional step of "ascertaining quantitative information by collecting data derived from use of the testing material on the subject" does not require a computer or other machine. The remaining dependent claim 2-10 do not cure the 101 deficiency of the independent claim. Accordingly, claims 1-10 and 24 identify neither the apparatus performing the recited steps nor any transformation of underlying materials, and, therefore, is directed to non-statutory subject matter.

As per system claim 11, the claim recites only a computer-readable medium and *means* for enabling the recited functionalities which (means) could be understood as merely software or code per se. As such, it appears that the claim is directed to two statutory subject classes - an apparatus and product of manufacture. So as the remaining dependent claims 12-19 do not cure the identified deficiencies of independent claim 11, they are also rejected as being directed to non-statutory subject matter.

(10.02) Applicant argues that Maloney and Otworth does not teach or suggest "selecting a set of personal questions from..., personal questions stored on [a] computer-readable storage medium," as recited in claim 1.

In response to this argument it is noted that Maloney teaches that "consumer profiling data may be collected through a user interface" (page 6, lines 30-31), and that

said user interface provides the consumer with a list of interaction options that correspond to the personalized profile, said interaction options are stored in the data repository (page 17, lines 26-29). Figs. 11 and 12 further disclose exemplary questions for eliciting said consumer profiling information (page 19, lines 14-15). Maloney not only disclose the recited method steps (page 12, lines 4-20), but also an apparatus used in conducting said method steps (page 14, lines 3-32). Accordingly, said personal questions, disclosed in Maloney, are presented via a computer interface, thereby disclosing that said personal questions are stored on [a] computer-readable storage medium.

(10.03) Applicant argues that neither Maloney nor Otworth, nor any combination thereof, discloses or suggests "based on... received answers [to a set of personal questions selected from personal questions stored on computer-readable storage medium], selecting from a plurality of testing materials, at least one customized set of testing material," as recited in claim 1.

In response to this argument it is noted that Maloney suggests a step of *selecting* of at least one set of testing material because Maloney teaches: providing the subject with at least one set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject (page 11, lines 7-9) and informing the subject about the at least one set of testing material (page 11, lines

13-14). As per a "*customized set*" feature; and a "*plurality* of testing materials" feature, Otworth was applied to disclose said features. Specifically, Otworth teaches *based upon collected historical data (subject's data)* related to a subject, providing the subject with a *customized* kit for collecting the biological sample from the subject, wherein said kit includes at least one replaceable cartridge which is determined/selected based on the tests determined to be conducted on the subject (*plurality* feature) [0043]; [0040].

(10.04) Applicant argues that Otworth does not teach or suggest that the historical data related to the subject include "answers to [a] set of personal questions," as recited in claim 1, or that the historical data related to the subject are obtained through "selecting a set of personal questions from..., personal questions stored on [a] computer-readable storage medium," "asking a subject the set of personal questions," and "receiving answers to the set of personal questions," as recited in claim 1.

In response to this argument the examiner maintains that Maloney discloses the recited features (See the response to the argument in 10.02). To this end it is noted that Applicant presents arguments against the references individually, but one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(10.05) Applicant argues that neither Maloney nor Otworth, nor any combination thereof, discloses or suggests "maintaining an inventory of a plurality of differing groups of customized sets of testing material, each group containing a combination of testing material different from a combination in another group, and..., selecting and shipping [to a subject] an appropriate set from a group maintained in inventory," as recited in claim 8.

In response to this argument it is noted that Maloney suggests that said selected, appropriate (customized) set, which is shipped to the consumer, is readily available for each consumer in each of said profile sub-categories, because Maloney teaches that said profiling of the consumer is based on consumer's physiological preferences and physiological conditions, said conditions including skin type and life stage, said profiling further includes assigning the consumer to various profile sub-categories which correspond to specific beauty product categories (page 6, line 32 – page 7, line 12). Other words, in Maloney, every consumer assigned to a specific profile sub-category receives an appropriate set of testing materials. Otworth teaches that said kit (set) includes at least one replaceable cartridge which is determined/selected based on the tests determined to be conducted on the subject [0043] (see reasoning applied to Claim 1), thereby suggesting *maintaining an inventory of a plurality of differing groups of customized sets of testing materials, each group containing a combination of testing material different from a combination in another group*. In fact, each reference suggests maintaining an inventory of a plurality differing groups of customized sets of testing

materials. Maloney does it at the specific profile sub-category level, while Orworth suggests at each consumer level.

The remaining applicant's arguments essentially repeat the arguments presented above; therefore, the responses presented by the examiner above are equally applicable to the remaining applicant's arguments.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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